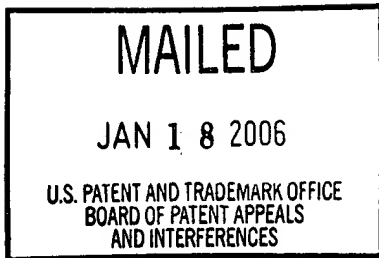


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL LEE HEARN



Appeal No. 2005-2097
Application No. 09/533,685

ON BRIEF

Before FRANKFORT, NASE, and BAHR, Administrative Patent Judges.
FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 22 through 30 and 33 through 38, all of the claims remaining in the application. Claims 1 through 21, 31, 32 and 39 have been canceled.

As noted on page 1 of the specification, appellant's invention relates generally to web printing presses, and more particularly to a folder for cutting a web into signatures. An objective of the invention is to provide a device for reliably cutting the signatures in a controlled fashion and to improve

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accuracy with regard to a "cut-to-cut" measurement as well as print-to-cut measurement in the signatures. Independent claims 22 and 33 are representative of the subject matter on appeal and a copy of those claims can be found in Appendix A of appellant's brief.

The prior art references relied upon by the examiner in rejecting the appealed claims are:

Sauer	3,522,762	Aug. 4, 1970
Wolfberg et al. (Wolfberg)	3,866,497	Feb. 18, 1975
Sturtz	4,249,441	Feb. 10, 1981
Littleton	5,103,703	Apr. 14, 1992

Claims 22, 30, 33 and 36 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Wolfberg.

Claims 23 through 25, 34, 35, 37 and 38 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wolfberg in view of Sturtz and Littleton.

Claims 26 through 29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wolfberg in view of Sturtz, Littleton and Sauer.

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding the rejections, we make reference to the examiner's answer (mailed September 22, 2004) for the reasoning in support of the rejections, and to appellant's brief (filed June 10, 2004) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims¹, to the applied prior art references, and to the respective positions articulated by appellant and the examiner. As a

¹During any further prosecution of the present application, the examiner and appellant should consider whether the currently claimed subject matter has written descriptive support in the originally filed application. More particularly, it appears that neither the specification nor drawings as originally filed provide support for the recitation in claims 22 and 33 regarding the first cutting cylinder nipping surface extending circumferentially about the first cutting cylinder "from the first blade edges" (emphasis added). This limitation seems to literally require that the first cutting cylinder nipping surface (114) extend circumferentially about the first cutting cylinder from the first blade edges (45) of the blade (4), not just circumferentially about the first cutting cylinder from the cutting blade (4). Thus, the layer of urethane (14) forming the outer surface of the cylinder would have a thickness equal to the height of the blade.

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consequence of our review, we have made the determinations which follow.

With respect to the rejection under 35 U.S.C. § 102(b) based on Wolfberg, we note that both of the independent claims on appeal set forth a cutting and nipping device having a first cutting cylinder having a first segmented cutting blade with axially spaced first blade edges and a first cutting cylinder nipping surface extending circumferentially about the first cutting cylinder from the first blade edges; and a first anvil cylinder having a first anvil cylinder nipping surface extending circumferentially about the first anvil cylinder; wherein the first cutting cylinder nipping surface and the first anvil cylinder nipping surface provide a first nip for the web about the first segmented cutting blade. In reading independent claims 22 and 33 of the present application on the cross-perforating system of Wolfberg, the examiner asserts that Wolfberg discloses a first cutting cylinder (e.g., 112) having a first segmented cutting blade (e.g., 114) with axially spaced first blade edges and a first cutting cylinder nipping surface (e.g., the surface adjacent the blades as shown in Figs. 6 and 10) extending circumferentially about the first cutting cylinder from the first

blade edges; and a first anvil cylinder (e.g., 116) having a first anvil cylinder nipping surface extending circumferentially about the first anvil cylinder; wherein the first cutting cylinder nipping surface and the first anvil cylinder nipping surface provide a first nip for the web about the first segmented cutting blade.

Appellant urges that the present invention requires the web to be nipped between the first cutting cylinder and the first anvil cylinder using the first cutting cylinder nipping surface extending circumferentially about the first cutting cylinder from the first blade edges and the first anvil cylinder nipping surface extending circumferentially about the first anvil cylinder, and that one of ordinary skill in the art would understand a "nip" in a web printing press as being a location where the web is squeezed or compressed together so that the web in the nip does not slip or move with respect to the cylinder in a way that could effect print-to-print or print-to-cut register (brief, page 4). In the portion of the brief spanning pages 4 and 5, appellant contends that Wolfberg discloses no such nipping arrangement and that in the context of the web of business forms

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specifically shown and described in that patent clearly would not nip the web.

We agree with appellant, and for that reason will not sustain the rejection of claims 22, 30, 33 and 36 under 35 U.S.C. § 102(b) based on Wolfberg. Although the examiner's position that the area where the cutting blade contacts the anvil cylinder and where the cut in the web is made constitutes a "nip" may be true, it is not the type of circumferential nipping arrangement defined in the claims on appeal. Moreover, even if the cylinders (112, 116) of Wolfberg each have a surface that contacts the web, as Figures 6 and 10 of the patent seem to show, the examiner's position that such contact alone will necessarily compress the web to at least some extent and thereby define a nipping arrangement like that claimed by appellant (answer, page 6), is based on total speculation and conjecture. In addition, we agree with appellant's evaluation of the device in Wolfberg and the reasons given on pages 4-5 of the brief as to why Wolfberg would not have a nipping arrangement for the sprocket driven, glued, superimposed sheets of paper and carbon paper forming the business form web disclosed therein. Concerning the examiner's rejections of dependent claims 23 through 29, 34, 35, 37 and 38

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under 35 U.S.C. § 103(a) based on combinations of Wolfberg, Sturtz, Littleton and Sauer, we have reviewed the additionally applied patents, but find nothing therein which makes up for or otherwise provides response for the deficiencies of Wolfberg noted above. Accordingly, we refuse to sustain the examiner's rejections of claims 23 through 29, 34, 35, 37 and 38 under 35 U.S.C. § 103(a).

In summary, we have decided not to sustain the examiner's rejection of claims 22, 30, 33 and 36 under 35 U.S.C. § 102(b) based on Wolfberg or the rejections of dependent claims 23 through 29, 34, 35, 37 and 38 under 35 U.S.C. § 103(a). Thus, the decision of the examiner to reject claims 22 through 30 and 33 through 38 of the present application is reversed.

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REVERSED

Charles E. Frankfort
CHARLES E. FRANKFORT
Administrative Patent Judge


JEFFREY V. NASE
Administrative Patent Judge

BOARD OF PATENT
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JENNIFER D. BAHR
Administrative Patent Judge

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